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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,160	03/18/2004	Ratan K. Chaudhuri	EMI-48 P1	4138
23599	7590	05/05/2006	EXAMINER	
MILLEN, WHITE, ZELANO & BRANIGAN, P.C.			FLOOD, MICHELE C	
2200 CLARENDON BLVD.			ART UNIT	
SUITE 1400			PAPER NUMBER	
ARLINGTON, VA 22201			1655	

DATE MAILED: 05/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/803,160

Applicant(s)

CHAUDHURI, RATAN K.

Examiner

Michele Flood

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 4-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

Applicant's election with traverse of Group I, Claims 1-3, in the reply filed on February 13, 2006 is acknowledged. The traversal is on the ground(s) that "a search of any of the methods results in a search for *all* of the methods". This is not found persuasive for all of the reasons set forth clearly in the previous Office action. For instance, the four different groups are directed to four different inventions, as the four different inventions are directed to four different methods having different functions and effects. Moreover, these methods are capable of separate manufacture, use or sale, as claimed, and are patentable (novel and unobvious) over each other (though they may be unpatentable because of the prior art) subjects. One would not have to practice the various methods at the same time to practice just one method alone.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-3 are under examination.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "low molecular weight" in claim 1 is a relative term which renders the claim indefinite. The term "low molecular weight" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

All other cited claims depend directly or indirectly from rejected claims and are, therefore, also, rejected under U.S.C. 112, second paragraph for the reasons set forth above.

#### ***Claim Objections***

Claim 1 is objected to because of the following informalities: There are apparent misspellings in line 7. Applicant may overcome the rejection by replacing "ant-acne" and ant-cellulite" with anti-acne and anti-cellulite. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ghosal (A\*).

Applicant claims a method for regulating the appearance of skin comprising topically applying to the skin a composition comprising (a) a cosmetically or pharmaceutically acceptable carrier and about 0.05% to about 5% of an extract comprising a low molecular weight hydrolysable tannin, and mixtures thereof, and, (b) an effective amount of at least one additional skin care active ingredient selected from the group consisting of anti-acne actives, retinoids, anti-cellulite agents, antimicrobial actives, antifungal agents, vitamins, anti-inflammatory agents, tanning agents, allantoin, glucosamine, phytantriol, hydroxyacids, niacinamide, phytosterols, sunscreens and mixtures thereof. Applicant further claims the method of claim 1, wherein the extract comprises over 40% of Emblicanin A, Emblicanin B, Pedunculagin, and Punigluconin. Applicant further claims the method of claim 2, wherein the extract comprises about 60% to about 85% of Emblicanin A, Emblicanin B, Pedunculagin, and Punigluconin.

Ghosal teaches compositions comprising a cosmetically or pharmaceutically acceptable carrier and an extract of *Emblica officinalis* comprising low molecular weight hydrolysable tannins within the range of about 0.1% to about 2% for use as a cosmetic for topical application to the skin (see examples 8-11); and, an effective amount of at least one additional skin care active agents selected from the claim-designated Markush group as recited in Claim 1 (such as methyl salicylate (an anti-inflammatory), camphor (a sunscreen), Germane (antimicrobial), allantoin, octyl methoxycinnamate (sunscreen)). The aforementioned examples 8-11 taught by Ghosal include moisturizing lotion (example 8), water-in-oil cold cream (example 9), skin rejuvenating lotion (example 10) and sunscreen spray-lotion (example 11) which all protect and

suppress skin aging for regulating the appearance of skin upon topical application (see Column 1, lines 12-16 and Column 7, line 13). Ghosal also teaches that the aforementioned plant extract comprises about 50% to about 80% Emblicanin A, Emblicanin B, Pedunculagin, and Punigluconin or 'Emblisome' (see Column 4, lines 55-60 and patent claim 8).

The teachings of Ghosal are set forth above. Ghosal does not expressly teach a method for regulating the appearance of skin comprising topically applying to the skin the claim-designated combination composition. However, it would have been obvious to one of ordinary skill in the art to apply the cosmetic compositions taught by Ghosal to provide the instantly claimed method because at the time the invention was made Ghosal taught compositions comprising a cosmetically or pharmaceutically acceptable carrier and about 0.05% to about 5% of an extract ('CAPROS") comprising low molecular weight hydrolysable tannins, wherein the extract comprises about 50% to about 80% Emblicanin A, Emblicanin B, Pedunculagin, and Punigluconin, were useful as topical compositions for protection of the skin against the sun and its damaging ultraviolet radiation. For example, Ghosal teaches a method of regulating the appearance of skin comprising topically applying an effective amount of an aqueous gel composition comprising 5% Emblisome (a gel containing 0.5% of CAPROS-lecithin complex) to the skin of humans, which provided complete protection for all against ultraviolet radiation-induced skin affliction, in Column 12, lines 12-58. At the time the invention was made, one of ordinary skill in the art would have been motivated and one would have had a reasonable expectation of success to apply the compositions taught

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by Ghosal comprising an effective amount of the aforementioned plant extract (CAPROS) and an effective amount of at least one additional skin care active agent selected from the claim-designated Markush group recited in Claim 1 to provide the instantly claimed method because Ghosal teaches that the compositions of his invention, which comprise each of the claim-designated ingredients of "(a) and (b)" as set forth in Claim 1, have the beneficial functional effect of regulating the appearance of skin comprising the topical application to skin, in Column 7, lines 10-12: "In use, the compositions of Examples 8-10 below suppress skin aging due to the effects of exposure to sunlight."

As the reference indicates that the various proportions and amounts of the ingredients used in the claim-designated pharmaceutical combinations are result variables, they would have been routinely optimized by one of ordinary skill in the art in practicing the invention disclosed by the reference in the making of the instantly claimed method.

Accordingly, the claimed invention was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, especially in the absence of evidence to the contrary.

\* Applicant is advised that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)), from the Office of Public Records and from commercial sources. Should you receive inquiries about the use of the Office's PAIR system, applicants may be referred to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Flood whose telephone number is 571-272-0964. The examiner can normally be reached on 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**MICHELE FLOOD**  
**PRIMARY EXAMINER**

Michele Flood  
Primary Examiner  
Art Unit 1655

MCF  
May 1, 2006